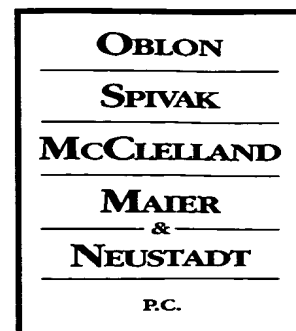




Docket No.: 244228US2X

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/687,634  
Applicants: Yoshitaka SASAKI, et al.  
Filing Date: October 20, 2003  
For: THIN FILM MAGNETIC HEAD AND  
MANUFACTURING METHOD THEREOF  
Group Art Unit: 3643  
Examiner: A.M. VALENTI

RECEIVED

JUL 27 2004

LICENSING & REGISTRATION

SIR:

Attached hereto for filing are the following papers:

**Reply to Denial of Petition for Retroactive License under 35 U.S.C. §184  
Statement under 37 C.F.R. §5.25(a)(3) in Support of Petition for  
Retroactive License under 35 U.S.C. §184**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

Richard L. Chinn, Ph.D.

Registration No. 34,305

Customer Number

**22850**

(703) 413-3000 (phone)  
(703) 413-2220 (fax)

Donald K. Drummond, Ph.D.  
Registration No. 52,834



DOCKET NO: 244228US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YOSHITAKA SASAKI, ET AL.

SERIAL NO: 10/687,634

FILED: OCTOBER 20, 2003

FOR: THIN FILM MAGNETIC HEAD  
AND MANUFACTURING METHOD  
THEREOF

: ATTN: LICENSING AND REVIEW

RECEIVED  
JUL 27 2004  
LICENSING DIV.STATEMENT UNDER 37 C.F.R. § 5.25(a)(3) IN SUPPORT OF PETITION FOR  
RETROACTIVE LICENSE UNDER 35 U.S.C. § 184COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

I, Yoshijiyo Abe, hereby certify that:

1. The above-identified application was not under a secrecy order at the time it was filed in Japan and it is not currently under a secrecy order.

2. I filed a corresponding application with the Japanese Patent Office on October 16, 2003 and learned that a first U.S. filing was required by U.S. law on February 10, 2004. I immediately sought advice from our U.S. representatives. Since then I have been diligently seeking a retroactive foreign filing license through our U.S. representatives.

3. I filed the application abroad through error and without deceptive intent. At the time I filed the application in Japan I did not know that U.S. law prohibited such filings. I discovered my error while looking through a file wrapper of an unrelated case and found a foreign filing license attached to the official filing receipt of the unrelated application. The

form cited 35 U.S.C. § 184 and after I checked the code I realized I should have obtained a foreign filing license for the above-identified application.

4. I declare under penalty of perjury under the law of the United States of America that the foregoing is believed to be true and correct.

  
\_\_\_\_\_  
Yoshijiro Abe

\_\_\_\_\_  
Date

DOCKET NO: 244228US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
YOSHITAKA SASAKI, ET AL. : EXAMINER: A.M. VALENTI  
SERIAL NO: 10/687,634 :  
FILED: OCTOBER 20, 2003 : GROUP ART UNIT: 3643  
FOR: THIN FILM MAGNETIC HEAD :  
AND MANUFACTURING METHOD  
THEREOF

REPLY TO DENIAL OF PETITION FOR RETROACTIVE LICENSE  
UNDER 35 U.S.C. § 184

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In regard to the above-identified application, Petitioners submit the attached Declaration. The Declaration is submitted to fully meet the requirements set forth in 37 C.F.R. § 5.25(a)(3). The Declaration is made by Yoshijiro Abe who is the person who had knowledge of the proscribed filing and made the decision to file abroad.

Petitioners now believe that all information required by 37 C.F.R. § 5.25(a) has now been submitted and Petitioners respectfully request that the Office grant the Petition.

Petitioners' U.S. representatives' address, facsimile number and telephone number are given below.

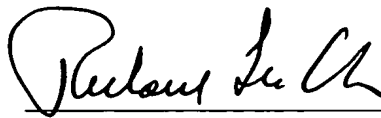
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

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22850

Tel: (703) 413-3000  
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(OSMMN 08/03)  
NFO:DKD:aps



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Richard L. Chinn, Ph.D.  
Registration No. 34,305

Donald K. Drummond, Ph.D.  
Registration No. 52,834

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/687,634	20-Apr-04	YOSHITAKA SASAKI, ET AL.	244228US2X

Title: THIN MAGNETIC HEAD AND MANUFACTURING  
METHOD THEREOF

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Art Unit	Paper Number
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Correspondence Address:  
NORMAN F. OBLON  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT  
1940 DUKE STREET  
ALEXANDRIA VA 22314

PATENT & TRADEMARK OFFICE  
**MAILED**

JUN 29 2004

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Norman F. Oblon  
OBLON SPIVAK MCCLELLAND  
MAIER & NEUSTADT  
1940 Duke Street  
Alexandria, VA 22314

In re: Yoshitaka Sasaki et al : DECISION ON REQUEST  
Serial No.: 10/687,634 : UNDER 37 CFR 5.25  
Filing date: 20 April 2004  
Docket No: 244228US2X

Title: THIN MAGNETIC HEAD AND MANUFACTURING METHOD THEREOF

This is a decision on the petition filed on 20 April 2004 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the declaration must be made by the person who was authorized to decide to file the foreign application. The declaration must include a statement along the lines that all statements made herein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under section 1001 of Title 18 of the United States Code.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



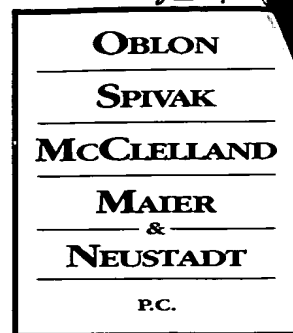
Andrea M. Valenti  
Patent Examiner  
Group 3643  
(703) 305-3010

16 June 2004



Docket No.: 244228US2X

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/687,634  
Applicants: Yoshitaka SASAKI, et al.  
Filing Date: October 20, 2003  
For: THIN FILM MAGNETIC HEAD AND  
MANUFACTURING METHOD THEREOF

SIR:

Attached hereto for filing are the following papers:

**Petition for Retroactive License under 35 U.S.C. §184**

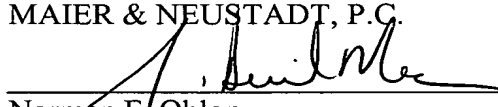
**Certification of Translation**

**English Translation of Application Serial No. 10/687,634**

Our check in the amount of \$130.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Norman F. Oblon

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